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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/870,342
Filing Date: May 29, 2001
Appellant(s): TSOU ET AL.

Brian W. Oaks
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/13/2009 appealing from the Office action mailed 11/17/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,968,179	DEVRIES	11-2005
2003/0004743	CALLEGARI	1-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, 4-6, 8-18 and 20-24, 26, 28, 30 and 32-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over De Vries (U.S. Patent No. 6,968,179).

Regarding claims 1, 2, 6, 18, 20, De Vries teaches transmitting business presence information (including an advertisement) to a user's wireless device based on physical location (Column 4, Lines 52-59). To receive such presence information, a user must perform a single action of arriving at a certain location (Column 11, Lines 46-54). The information service sends such information to the wireless device, and the physical device that operates the information service is a "business client system device". The user's wireless device has an instant messaging client installed thereon which handles the delivery of such location-specific messages (Column 7, Lines 35-39). De Vries teaches the storing of a number of "buddies" who wish to be notified of a

user's location, those "buddies" being people who view location information of a business when the user goes to the business (Column 7, Line 55 – Column 8, Line 5). This represents storing statistics in a database of the users who view the presence information. "Click statistics" is merely a name. Calling the statistics "click" statistics does not require any clicking actions to take place. No clicking is actively required by the claim language, and therefore the database of "buddies" who request user notifications reads over the claim language.

It could be argued that De Vries does not teach the specific data content of the physical location information as being address, phone number, directions, email address, or links. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of physical location data content in the physical location information. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claim 4, the user must first turn the wireless device on before receiving any messages. This is a step of clicking (or pressing) an "On" button.

Regarding claim 5, De Vries teaches receiving presence information when they are at a particular location (Column 11, Lines 46-54). If the device is not at that particular location (out of range), the user must move the device within range to permit transmission of the presence information.

Regarding claims 8-12, 14, De Vries teaches multiple users with wireless devices having instant messaging clients installed thereon with buddy lists having a listing of the first instant messaging user. The first user's presence information is transmitted to the other users for viewing through the buddy list (Column 7, Line 44 - Column 8 Line 5). Any display of text indicating a user's presence is considered an "icon".

Regarding claim 13, if the first user is at a merchant location, this will be displayed to the other buddy list users independent of any selection (whether a user selects such information or not).

Regarding claims 15-17, De Vries teaches sending user-profile information for targeting purposes (Column 11, Lines 46-54). A user profile must inherently contain contact information (IP Address or other such device identifying information) in order to receive messages to the wireless device. Turning on the device reads on enabling the wireless device.

Regarding claims 21 and 24, De Vries teaches transmitting business presence information (including an advertisement) to a user's wireless device based on physical location (Column 4, Lines 52-59). To receive such presence information, a user must perform a single action of arriving at a certain location (Column 11, Lines 46-54). The information service sends such information to the wireless device, and the physical

device that operates the information service is a "business client system device". The user's wireless device has an instant messaging client installed thereon which handles the delivery of such location-specific messages (Column 7, Lines 35-39). De Vries teaches storing activity information ("statistics reports" on activity) for user's such as if the user is a coffee drinker or a vegetarian (Column 11, Lines 53-54).

It could be argued that De Vries does not teach the specific data content of the physical location information as being address, phone number, directions, email address, or links. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of physical location data content in the physical location information. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claims 22 and 23, De Vries teaches sending user-profile information for targeting purposes (Column 11, Lines 46-54). By submitting profile information, a user inherently "agrees" to submit the profile.

Regarding claim 26, the user activity preference report must be in some form of printed text information to be understood by users.

Regarding claims 28, and 32, De Vries teaches transmitting business presence information (including an advertisement) to a user's wireless device based on physical location (Column 4, Lines 52-59). To receive such presence information, a user must perform a single action of arriving at a certain location (Column 11, Lines 46-54). The information service sends such information to the wireless device, and the physical device that operates the information service is a "business client system device". The user's wireless device has an instant messaging client installed thereon which handles the delivery of such location-specific messages (Column 7, Lines 35-39). De Vries teaches multiple users with wireless devices having instant messaging clients installed thereon with buddy lists having a listing of the first instant messaging user. The first user's presence information is transmitted to the other users for viewing through the buddy list (Column 7, Line 44 - Column 8 Line 5). De Vries teaches the storing of a number of "buddies" who wish to be notified of a user's location, those "buddies" being people who view location information of a business when the user goes to the business (Column 7, Line 55 – Column 8, Line 5). This represents storing statistics in a database of the viewing of the presence information. "Click statistics" is merely a name. Calling the statistics "click" statistics does not require any clicking actions to take place. No clicking is actively required by the claim language, and therefore the database of "buddies" who wish for notification reads over the claim language.

It could be argued that De Vries does not teach the specific data content of the physical location information as being address, phone number, directions, email address, or links that contain further specific data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have included any type of physical location data content in the physical location information. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claim 30, De Vries teaches sending promotional information to users (Column 11, Lines 44-54). Should a user and another user both be nearby, they would get the same promotional message and this reads on the claim language.

Regarding claims 33 and 34, De Vries teaches instant messaging clients as interacting over the Internet (Column 1, Lines 46-50).

Regarding claim 35, De Vries teaches storing a name database (Column 13, Lines 31-46).

Regarding claim 36, De Vries teaches storing activity information ("statistics reports" on activity) for user's such as if the user is a coffee drinker or a vegetarian (Column 11, Lines 53-54).

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over De Vries (U.S. Patent No. 6,968,179) in view of Callegari (U.S. Pub No. 2003/0004743).

Regarding claim 31, De Vries teaches subscribing to alert and notification messages (Column 5, Lines 60-61). De Vries does not appear to specify linking a user to a website in order to subscribe. Callegari teaches a multi-user location-sharing system using buddy lists (Paragraph 0080) in which users are directed to the website of a merchant in which they are visiting (Paragraph 0108). It would have been obvious to one having ordinary skill in the art at the time the invention was made to direct a user to a merchant's website to subscribe to further notifications in the interest of having that user further view more advertising for the merchant in the form of the website.

(10) Response to Argument

Appellant argues "the Examiner is ignoring the words physical location as a modifier of the term information. The claims specifically require this type of information and, in fact, provide a Markush grouping reciting various examples of physical location information". Certain options under the Markush grouping in question include "'phone number", email address information", and "one or more links to Internet websites". Examiner contends that there is no physical location inherent in any of these options. A

cell phone number does not guarantee that a cell phone is located in any particular location. A website is not a physical location. An email addressed can be checked from any Internet-capable computer anywhere in the world. Further, regardless of the information that is received, the steps of the method are performed the same way. A device performing the method of Appellant's invention, except merely transmitting a different type of information instead of those listed in the Markush grouping would not be distinguishable as a different invention. A type of data is not a patentable distinction, and it would be obvious to send any type of data, as the type of data is not functionally relevant to the steps. 2 devices performing the same operations, but sending or storing different information, are not patentably distinct. This would be the equivalent of saying the letter "a" is patentably distinct from the letter "b". Unless specific data is used to further the method, it would be obvious to include any data as explained in the claim rejections.

Appellant states that they have "chosen to be their own lexicographer" and argues "Paragraph 48 defines a click statistic as a statistic associated with the selection of presence information by instant messaging users". Examiner contends that the cited section of the specification is directed towards a "click statistics report", not a click statistic stored in a database. Further, the entire sentence from the specification states "A click statistics report may also be generated by IM server 302, which contains statistics associated with the selection of presence information by instant messaging users". First of all, this is not a definition, as Appellant has not stated that the term is not be defined as such. Second of all, it is unclear from this sentence if the click

statistics report contains the particular statistics in question, or if the click statistics report may be generated by the IM server, and it is the IM server that contains the statistics in question. Appellant is not at liberty to claim broad concepts and point to the specification for a narrower interpretation when that interpretation is ambiguous and does not even constitute a definition.

Further, there is no "clicking" required by the claim language. There is no selection of data required by the claim. However, for the sake of argument, Examiner contends that the cited section of De Vries teaches the storing of selections, by buddies, of presence information requested to be viewed. While the language in paragraph 48 of the specification is not considered to be a definition of the term "click statistics", this interpretation does in fact meet the language in the specification.

Appellant argues "the Final Office Action first argues that this entry of user profile information is a disclosure of a statistic report sent by the user, but this is clearly not a statistic report given the broadest reasonable meaning of the term in light of the specification". Examiner contends that the data supplied is statistical data (coffee drinker, vegetarian, etc.) and therefore, according to a broadest reasonable interpretation this is in fact a statistics report. The claim does not limit the statistics report to exclude this type of information, and therefore this section of the prior art does indeed read over the broad claim language.

Appellant further argues "it is not a statistic report of the user's activity in selecting said business information of said business. A user providing profile information that the user is a coffee drinker or a vegetarian is clearly not related to a

user's selection of the previously recited information of a business". Examiner would like to point out that this is not required by the claim language. The claim language recites "receive and store statistic reports on activity of said instant messaging user in selecting said business information of said business". Examiner reads this limitation as storing reports on the activity of a user, and those reports are used in selecting business information to provide to a user. Examiner read the meaning of the word "in" as being similar to "in the interest of". Contrary to Appellant's assertion, this is not a convoluted interpretation, as this is a common use for the word "in". The claims may be interpreted 1 of 2 different, perfectly reasonable, ways. While Appellant may have intended the claimed statistic report to include information relating to user-selected business information, this is not required by the claim as currently written.

Appellant argues "there is no disclosure that statistic reports are received from an instant messaging server or that they comprise information for business analysis and measurement of a marketing success of said transmitted business information". Changes to a profile would inherently occur through a server of the instant messaging network, and thus, the reports would be received from the server. The reports comprise information, but the analysis and measurement portions of the claim are intended use and do not actively limit the claim ("comprise information **for** business analysis and measurement of a marketing success"). Further, each of these recitations are recited in the claim language using wherein clauses, which also do not actively limit the claim. Even further, this argument is directed to a system claim, and where the information is received from does not limit the actual device itself. The following sections of the MPEP

are believed to be relevant in regards to structural limitations within system claims and wherein clauses:

MPEP 2114 states:

While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. A claim containing a **"recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus"** if the prior art apparatus teaches all the structural limitations of the claim.

MPEP 2106 (II) (C) states:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope.

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) **"wherein" clauses**, or
- (D) "whereby" clauses.

USPTO personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. **Limitations appearing in the specification but not recited in the claim should not be read into the claim.**

Appellant argues "De Vries does not disclose, teach or suggest presence information that includes a link to advertisements for a business". This is part of the physical presence information, and the same arguments used above are relevant here as well with regards to the non-functional descriptive material. Even though the presence information and the contents of that information is merely non-functional types of data, Merriam Webster's online dictionary further defines "link" as "a connecting element or factor". Therefore, De Vries is still an appropriate teaching for this limitation, as there is an implicit connection between the presence information and advertisements in De Vries. Regardless, a type of data is still not a patentable distinction, and it would be obvious to send any type of data, as the type of data is not functionally relevant to the steps. 2 devices performing the same operations, but sending or storing different

information, are not patentably distinct. This would be the equivalent of saying the letter "a" is patentably distinct from the letter "b". Unless specific data is used to further the method, it would be obvious to include any data as explained in the claim rejections.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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